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REMARKS

Claims 8-25 are currently pending in the subject application and are presently under consideration. Claim 1-7 and 26-28 have been cancelled herein without prejudice or disclaimer. Favorable reconsideration of the subject patent application is respectfully requested in view of the amendments and comments herein.

**I. Rejection of Claims 1-24 and 16-21 Under 35 U.S.C. §102(b)**

Claims 1-7 and 16-21 stand rejected under 35 U.S.C. §102(b) as being anticipated by "A Common Object Model Discussion Paper" by the Workflow Management Coalition (hereafter "WfMC"). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. WfMC does not teach or suggest each and every limitation as set forth in the subject claims.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. *Trintec Industries, Inc., v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 U.S.P.Q.2D 1597 (Fed. Cir. 2002). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently *described* in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 1-7 have been cancelled herein without prejudice or disclaimer. Accordingly, the rejection of these claims is moot.

Independent claim 16 recites a binding component that separates a schedule (which includes a definition of a flow of business operations) from implementations of a workflow and ***maps actions in the schedule to calls on at least one technological component***. The Examiner asserts WfMC teaches such aspects of the subject claim and references page 8, section 3.1 of WfMC to support his assertion. The Examiner contends that this section of WfMC states "[t]he ability to establish dynamic bindings with location service between different workflow components or between different workflow services..." Applicants' representative respectfully disagrees. Rather, section 3.1 of WfMC states "[t]he ability to establish dynamic bindings with

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location service between different workflow components or between different workflow services ... *will become increasingly important*....” (Emphasis added). From this excerpt, it appears the Examiner has referenced section 3.1 of WfMC out of context. WfMC does not teach dynamic bindings. Instead, WfMC simply opines that dynamic bindings will become important in the future and does not provide any enabling disclosure for dynamic bindings. Thus, this rejection is improper. (See *In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985) (stating that it is well settled that prior art under 35 U.S.C. §102 must sufficiently describe the claimed invention and that even if the claimed invention is disclosed that disclosure will not suffice as prior art if it was not enabling)).

Moreover, section 3.1 of WfMC relates to bindings “between workflow components” or “between workflow services.” In contrast, independent claim 16 recites mapping *actions in a schedule to calls on a technological component*. In the subject Advisory Action, the Examiner asserts that bindings between workflow services inherently teach links between such services and technological components. Applicants’ representative respectfully disagrees and submits that the relationships between workflow services describes that class of relationships – between workflow services – but does not teach or suggest mapping actions in a schedule to calls on a technological component as recited in the subject claims.

In view of the above, the rejection of independent claims 16 (and claims 7-21, which depends there from) should be withdrawn.

## **II. Rejection of Claims 8-15 and 22-28 Under 35 U.S.C. §103(a)**

Claims 8-15 and 22-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over WfMC in view of “Executable Workflows: A Paradigm for Collaborative Design on the Internet” by Lavana, *et al.* (hereafter “Lavana, *et al.*”). It is respectfully submitted that this rejection should be withdrawn for the following reasons. WfMC and Lavana, *et al.*, individually and in combination, do not teach or suggest all elements of the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

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combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Independent claim 8 recites a scheduling component that employs a *dataflow diagram that defines a flow of business operations and includes actions coupled via data flowing between them*, and a binding component that defines business operations through a *schedule message, a port connection, a port and a message interface* with a component outside of the schedule. The Examiner concedes WfMC does not teach or suggest a dataflow diagram, but contends that Lavana, *et al.* teaches such aspects and that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of WfMC and Lavana, *et al.* to render the subject claim. However, neither cited figure (Figure 2 and Figure 6) is a dataflow diagram that defines a flow of business operations or includes actions coupled via data flowing between them as recited in the subject claim. Figure 2 of Lavana, *et al.* describes an "Internet-based workflow" that implements a "recursive application of a bi-partitioning tool that partitions a large netlist into a tentative partition and a remainder," and Figure 6 describes a template editor with a partitioner program node with data file dependencies. The Examiner further contends that WfMC teaches a binding component that defines business operations through a schedule message, a port connection, a port and a message interface with a component outside of the schedule. The Examiner references page 8, section 3.1, and page 7, section 2.2.2, to support this contention. However, these sections are silent regarding defining business operations through a schedule message, a port connection, a port and a message interface.

Independent claim 22 recites a file with a plurality of disparate business implementations and a binding module that allows *a user to define a link between the file with business operations and the plurality of disparate business implementations*. The Examiner asserts that WfMC teaches a binding module that allows a user to define a link between a file with business operations and a plurality of disparate business implementations. The Examiner references page 8, section 3.1, and page 7, section 2.2.2, of WfMC to support this assertion. However, these sections do not mention a binding module, disparate business implementations, or a user defined link between business operations and disparate business implementations as recited in the subject claim.

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Claim 25 (which depends from independent claim 22) further recites that the link is in a programmable language having *XML* syntax. The Examiner asserts that WfMC discloses that XML may have a role in the ability to transfer a business project as a work on and that it would have been obvious to one of ordinary skill in the art at the time of the invention to use XML as disclosed by WfMC to teach the subject claim. Applicants' representative respectfully disagrees. WfMC states that "[a] dynamic form of binding a (sub-)process to a service provider organisation is desirable to provide this flexibility. The implication is that some form of standardised representation of the operational business process instance is required ... *[a non-trivial problem; note that XML may also have a role to play in this area]*." (See p. 9, §3.2). From the above, it is readily apparent that WfMC renders an opinion based on an alleged desire and concedes that this is an unsolved "non-trivial problem," noting that XML "may" have a role to play in this area. Thus, there is no teaching or suggestion in WfMC to use XML to result in the subject claim or a reasonable expectation of success of the purported modification, and both must be found in the prior art, not in applicants' disclosure. (See *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991)). The mere fact that the reference can be modified does not render the modification obvious unless the referenced art also suggests the desirability of the modification. (See *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990)).

Claims 26-28 have been cancelled herein without prejudice or disclaimer. Accordingly, the rejection of these claims is moot.

In view of the foregoing, it is respectfully requested that the rejection of independent claims 8 and 22 (and dependent claims 9-15, 23-25) be withdrawn.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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